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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/845,497	05/01/2001	Amina Odidi	9577-25 LAB	2340
7590 Lola A. Bartoszewicz Sim & McBurney 6th Floor 330 University Avenue Toronto, ON M5G 1R7 CANADA				
			EXAMINER PRYOR, ALTON NATHANIEL	
			ART UNIT 1616	PAPER NUMBER
			MAIL DATE 03/02/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/845,497

Applicant(s)

ODIDI ET AL.

Examiner

ALTON N. PRYOR

Art Unit

1616

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,6-9,11,15-17,21-32 and 34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,6-9,11,15-17,21-32,34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Applicant's arguments filed 12/4/08 have been fully considered but they are not persuasive. See arguments below. Previous rejections and issues not discussed below have been withdrawn.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,6-9,11,15-17,21-32,34 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Dolan et al (USPN 6106864; 8/22/00) and Dong et al (USPN 5800422; 9/1/98) and Cheng on record (USPN 6099859; 8/8/00). Dolan teaches oral dosage forms of actives such as darifenacin. See column 2 lines 34-52. Dolan teaches that the matrix comprising the active can be formed into a multiparticulate and / or coated with an impermeable coating. See column 2 lines 53-57. Dolan teaches that the multiparticulate cores comprising the actives can also contain cellulose and lactose (compression aids). See column 3 lines 1-7. Dolan teaches that the ingredients can be formulated into a tablet which can be coated with shellac, phthalate derivatives (cellulose acetate phthalate, polyvinylacetate phthalate) as well as with semi-permeable coatings such as cellulose esters (ethyl cellulose, cellulose acetate) and acrylic polymers. See column 3 lines 7-38. Dolan does not teach the polymeric coating comprising 1) 5 up to less than 50% by weight polymer, e.g. ethyl cellulose 2) 0.5 to 30% PEG. Dolan is silent to the amount of polymer in the coating. Therefore, in the absence of unexpected results showing the significance of the instantly claimed amount of polymer, the ideal amount of polymer used in

Dolan may have fallen within the instant range of polymer amount being claimed. With respect to the polymeric film comprising PEG. Dong discloses the use of PEG in a capsule film coating. Note, Dong uses 25 % PEG in the polymer coating which falls within the instantly claimed range amount. Cheng teaches that PEG is a flux-enhancing agent. A flux-enhancing agent allows the drug to be released through the pores of the polymeric coating. It would have been obvious to one having ordinary skill in the art to modify the invention of Dolan to include the PEG to enhance the release of the drug through the pores of polymeric coating. Although claims require the polymeric material to be non-permeable, it is noted that the claims employ polymeric films such as cellulose esters and acrylic polymers which are semi-permeable. For this reason the rejection appears to be proper. Note the property of the polymeric coating being soluble at a pH above 5.0 and having an extended release of the active over 12 hours are inherent properties of the polymer (cellulose esters) and PEG being used.

Response to Applicant's argument

The Applicants argue that Dolan does not teach / suggest an encasement coat being non-permeable as a whole and soluble in pH of above about 5. The Examiner argues that Dolan teaches that the active ingredients can be formulated into a tablet which can be coated with shellac, phthalate derivatives (cellulose acetate phthalate, polyvinylacetate phthalate) which are impermeable and soluble at a pH greater than 5 (Dolan column 3 lines 7-38). In the instant invention, where shellac or phthalate derivatives (cellulose acetate phthalate, polyvinylacetate phthalate) serve as the coating materials the limitation of the invention with respect to the coating is met. Note, the instant specification employs said polymers as coating materials (specification paragraph 39).

Applicants argue that Dolan teaches that impermeable coating is non-enteric and must have an aperture. The Examiner argues that Dolan teaches that the tablet is coated with cellulose acetate and polyvinyl acetate phthalate which would meet the limitation of coating types recited in instant claims 9 and 21 and which would meet the pH solubility limitations recited in the claims (Dolan column 3 lines 7-38). Note, instant application like Dolan teaches that cellulose acetate and polyvinyl acetate phthalate are desired coatings (instant claims 9 and 21). The instant claims employ comprising language which renders polymer coatings open to having an aperture.

Applicants argue that Dolan does not teach or suggest an encasement coat being both non-permeable and soluble in a pH of above about 5.0 as instantly claimed. Applicant provides a declaration showing that cellulose acetate does not meet the requirement of being both non-permeable and soluble in a pH of above about 5.0 as claimed. Although Applicants have shown this statement to be true with respect to cellulose, the Examiner argues that Dolan teaches the some of the same coating materials (e.g. polyvinyl acetate phthalate) as those recited in instant claims 9 and 21 for the tablet; therefore it is expected that Dolan's coatings (e.g. polyvinyl acetate phthalate) are both non-permeable and soluble at a pH of above about 5.0.

Applicants argue that the specific combination of the claimed invention, i.e. the combination of polymer and PEG, yields a coating that is both non-permeable and soluble at a pH of above about 5.0. An artisan in the field would not have considered adding PEG to the coating of Dolan to achieve an impermeable coat since an impermeable coat of Dolan is associated with non-enteric coat. The Examiner maintains that it would have been obvious to include the PEG taught by Dong or Chen to control the release of the drug through the polymeric coating. PEG is a common material used in coats for tablets for drug control release.

Telephonic Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alton N. Pryor whose telephone number is 571-272-0621. The examiner can normally be reached on 8:00 a.m. - 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alton N. Pryor/
Primary Examiner, Art Unit 1616